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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,128	12/26/2001	David C. Collier	214	3434

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PATENT DEPARTMENT
MACROVISION CORPORATION
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EXAMINER	
SHIFERAW, ELENI A	
ART UNIT	PAPER NUMBER
2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/036,128	COLLIER ET AL.	
	Examiner	Art Unit	
	Eleni A. Shiferaw	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,24-26,37-56 and 72-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,24-26,37-56 and 72-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01/08/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/08/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The word "substantially", in lines 3, 5, 7, 10 and 11, is indefinite in that it fails to point out what is included or excluded by the claim language.

4. Claims 24, 25, 26, 74, and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

5. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The word "substantially", in lines 3, 6, and 8, is indefinite in that it fails to point out what is included or excluded by the claim language.

6. Claim 73 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The word "substantially", in lines 2, 5, 7, 9 and 10, is indefinite in that it fails to point out what is included or excluded by the claim language.

7. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The word "substantially", in lines 3, 6, and 8, is indefinite in that it fails to point out what is included or excluded by the claim language.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 76 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **It is not practical application and/or no result of *"accessing material"* as it is introduced in the preamble of the claim.**

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-11, 24-26, 37-56, and 72-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kori (Patent No.: US 2001/0053979 A1) in view of Kataoka et al. USPN 5,857,021.

Regarding claims 1 and 73, Kori discloses an apparatus for accessing material, comprising:

a secure registry encrypted with a registry key (0034, fig. 3A and fig. 11) that was generated by using *an identification of an access authorized entity* (0056; *kc is created using user's password identifier*), and storing another key useful for decrypting material (fig. 11; *stored encrypting key*); and

decrypt said secure registry using a registry key for retrieval of said another key (0082).

Kori fails to disclose generating a registry key by using users password identifier but not disclose generating a registry key by using a *substantially* unique manufacturer assigned identification of host (hardware device connectable to the apparatus) and a control module configured to read a memory stored *substantially* unique manufacturer assigned identification of the apparatus (hardware device connectable to the apparatus), regenerate said registry key by using the memory stored substantially unique manufacturer assigned identification and decrypt using said regenerated registry key and the *substantially* unique manufacturer assigned identification and the memory stored *substantially* unique manufacturer assigned identification are the same.

However Kataoka et al. teaches a data encoding unit comprising a first key generating means that generates a key by using a **medium ID** that is an identifier uniquely assigned by the manufacturer to each medium (see col. 4 lines 29-30) and by using **unit ID** that is an identifier uniquely assigned to the computer (see col. 7 lines 9-12), and a first encrypting means and a

second encrypting means to encrypt encryption key and data respectively (see col. 6 lines 57-col. 7 lines 26), data/content is encrypted using data encryption key/permission data, and data encryption key and/or permission data is also encrypted using another key/private key, Kataoka et al. also discloses a data decoding unit comprising a second key generating means that regenerates another key/private key by using **same medium ID and same unit ID** to decrypt permission key/data encryption key that decrypts the data/content (see col. 7 lines 27-40 and fig. 9).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Kataoka et al. with in the system of Kori because they are analogous in data encryption and data security. One would have been motivated to incorporate the teachings of Kataoka et al. within the system of Kori because it would secure the data protection system by regenerating a key from the same seed identifier and/or if the key is regenerated from unknown seed identifier the system would not allow a decryption access to the data and further enhance data/copy protection security.

As per claim 76, Kori teaches a method for accessing material, comprising:

receiving (0082) a secure registry that has been encrypted with a registry key (0034, fig. 3A and fig. 11) that was generated by using identification of an access authorized entity (0056; *kc is created using user's password identifier*);

storing the received security registry in a memory of the host (0090); and

decrypting said secure registry with a registry key (0082);

Kori fails to disclose reading a memory stored *substantially* unique manufacturer assigned identification of a hardware device connected to the host; and regenerating said registry key using the memory stored *substantially* unique manufacturer assigned identification; and decrypting the secure registry key using regenerated registry key from unique *substantial* manufacturer assigned identification.

However Kataoka et al. teaches a data encoding unit comprising a first key generating means that generates a key by using a **medium ID** that is an identifier uniquely assigned by the manufacturer to each medium (see col. 4 lines 29-30) and by using **unit ID** that is an identifier uniquely assigned to the computer (see col. 7 lines 9-12), and a first encrypting means and a second encrypting means to encrypt encryption key and data respectively (see col. 6 lines 57-col. 7 lines 26), data/content is encrypted using data encryption key/permission data, and data encryption key and/or permission data is also encrypted using another key/private key, Kataoka et al. also discloses a data decoding unit comprising a second key generating means that regenerates another key/private key by using **same medium ID and same unit ID** to decrypt permission key/data encryption key that decrypts the data/content (see col. 7 lines 27-40 and fig. 9).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Kataoka et al. with in the system of Kori because they are analogous in data encryption and data security. One would have been motivated to incorporate the teachings of Kataoka et al. within the system of Kori because it would secure the data protection system by regenerating a key from the same seed identifier and/or if the key

is regenerated from unknown seed identifier the system would not allow a decryption access to the data and further enhance data/copy protection security.

Regarding claim 42, it has similar limitations as claim 76 therefore it is been rejected based on the same rational as claim 76 above. In addition, both Kori and Kataoka et al. disclose the additional limitation wherein

retrieving another key from said decrypted secure registry (Kori 0082-0083; Kataoka et al. col. 6 lines 57-col. 7 lines 26); and

decrypting encrypted material using said another key to access said material (Kori Fig. 13, and 0082; Kataoka et al. col. 7 lines 27-40).

As per claims 2, 7, and 43, Kori further teaches the apparatus, wherein said control module receives said material as streaming media, and is further configured to decrypt said material using said another key (Kori page 2 par. 0028, page 5 par. 0082, and par. [0086-0088]).

As per claims 3, 8, 44, and 51 Kori further teaches the apparatus, wherein said streaming media/file is in MPEG-4 format encrypted with at least one content key, and said control module receives said at least one content key encrypted with said another key (0033).

As per claims 4, 9, 46, and 53, Kori further teaches the apparatus, wherein said another key comprises at least one license key corresponding to a license to use said material (Kori fig. 11, 0034, 0082; encrypting key).

As per claims 5, 10, 47, and 54 Kori teaches the apparatus, wherein said streaming media/file is in MPEG-4 format encrypted with at least one content key, and said control module receives said at least one content key encrypted with a public key of said apparatus (Kori page 5 par. 0081).

As per claims 6 and 11, Kori further teaches the apparatus, wherein said another key comprises a private key of said apparatus (Kori page 5 par. [0080-0081]).

As per claim 24, Kataoka et al. teaches the apparatus, wherein said identification of said current entity is a computer identification (col. 6 lines 57-col. 7 lines 40 and fig. 9).

As per claim 25, Kori and Kataoka et al. teach all the subject matter as described above. In addition, Kataoka et al. teaches the apparatus, wherein said identification of said current entity is a network interface card identification (the Examiner takes an official notice on wherein said ID of the current entity is a network interface card (NIC) ID because it would be obvious to one ordinary skill in the art at the time of the invention was made to employ the system of computer identification seed with network interface card identification in order to use network interface card ID unique seed because identifier is just a binary seed and would identify and work for NIC).

As per claim 26, Kataoka et al. further teaches the apparatus, wherein said identification of said current entity is a hard disk drive identification (col. 8 lines 30-col. 11 lines 7).

As per claim 37, Kori further teaches the apparatus, wherein said control module comprises a processor and a control program running on said processor (Kori fig. 8 No. 11).

As per claim 38, Kori further teaches the apparatus, wherein said control module includes logic circuitry (0066).

As per claim 39, Kori further teaches the apparatus, wherein said control module is license-enabled to a unique identification of said apparatus (0060-0061).

As per claim 40, Kori further teaches the apparatus, wherein said secure registry further stores information related to said material (Kori fig. 11; audio/video data).

As per claim 41, Kori teaches the apparatus, wherein said information related to said material includes usage rights included in a license for said material (Kori fig. 3A, and page 2 par. 0034, and fig. 11).

As per claim 45, Kori teaches the method, wherein said decrypting encrypted material using said another key to access said material, comprises:

decrypting said at least one content key with said another key (Kori page 5 par. 0082); and

decrypting said encrypted material with said at least one content key to access said material (Kori page 5 par. 0082).

As per claims 48, and 55, Kori teaches the method, wherein said another key comprises a private key of said recipient of said material (Kori page 5 par. 0081-0082).

As per claims 49 and 56, Kori teaches the method, wherein said decrypting encrypted material using said another key to access said material, comprises:

decrypting said at least one content key with said private key (Kori page 5 par. 0081-0082); and

decrypting said encrypted material with said at least one content key to access said material (Kori page 5 par. 0081-0082).

As per claim 50, Kori teaches the method, further comprising receiving said encrypted material as a file (Kori page 5 par. 0086-0088).

As per claim 52, Kori teaches the method, wherein said decrypting encrypted material using said another key to access said material, comprises:

decrypting said at least one content key with said another key (Kori page 5 par. 0081-0082); and

decrypting said encrypted material with said at least one content key to access said material (Kori page 5 par. 0081-0082).

As per claim 72, Kori teaches the method, further comprising after said decrypted encrypted material using said another key to access said material:

using said material according to a license stored in said secure registry along with said another key (Kori page 5 par. 0081-0082).

Regarding claim 74, Kori and Kataoka disclose all the subject matter as described above. Regarding claim 74 Examiner takes an official notice wherein said substantially unique because Kori discloses generating/regenerating key from user identifier, and Kataoka discloses generating/regenerating key from uniquely assigned device identifier and it would be obvious to one ordinary skill in the art at the time of the invention was made to employ the system of generating/regenerating key from uniquely assigned device identifier with smart card identification in order to use smart card's unique seed because identifier is just a binary seed and would identify and work for smart card manufacturer assigned identification of said hardware device is smartcard identification (see Chasko et al. claim 20 for key generation from smart card serial number seed).

Regarding claim 75, Kataoka discloses the apparatus wherein said substantially unique manufacturer assigned identification of said hardware device is a content storage unit identification (see fig. 8 element 101 and 121).

Regarding claim 77, Both Kori and Kataoka disclose the apparatus comprising:

retrieving another key from said decrypted secure registry (Kori 0082-0083; Kataoka et al. col. 6 lines 57-col. 7 lines 26); and

decrypting encrypted material using said another key to access said material (Kori Fig. 13, and 0082; Kataoka et al. col. 7 lines 27-40).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 16, 2007

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2/16/07